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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,129	03/29/2004	David G. Whitten	8971-039-27 DIV	2489

7590

02/15/2005

Supervisor, Patent Prosecution Services
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EXAMINER

COUNTS, GARY W

ART UNIT

PAPER NUMBER

1641

DATE MAILED: 02/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/811,129

Applicant(s)

WHITTEN ET AL.

Examiner

Gary W. Counts

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-41 is/are pending in the application.
- 4a) Of the above claim(s) 19-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 03/29/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group VI, Claims 38-41 in the reply filed on December 28, 2004 is acknowledged. The traversal is on the ground(s) that examination of all currently pending claims would not pose an undue burden on the Examiner. This is not found persuasive because restriction requirements are set forth for reasons of patentable distinction between each independent invention so as to warrant separate classification and search. The record set forth in the previous restriction requirement clearly indicated that the delineated inventions are in fact patentably distinct each from the other or independent from the other. The requirement is still deemed proper and is therefore made FINAL.

Priority

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence(s) of the specification or in an application data sheet by identifying the prior application by application number (37 CFR 1.78(a)(2) and (a)(5)). If the prior application is a non-provisional application, the specific reference must also include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number. Also, the current status of all nonprovisional parent applications referenced should be included. For example, the first line of the specification should acknowledge that this

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application is a divisional of 09/850,074 filed 05/08/2001, now U.S. Patent No. 6,743,640.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 38-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 38, line 2 "amplified superquenching" is vague and indefinite. It is unclear what applicant intends. There is no definition provided for the term in the specification.

Claim 38, line 3 "associated therewith" is vague and indefinite. It is unclear if the property-altering element binds to the fluorescent polymer or if the property-altering element merely comes in contact with the fluorescent polymer or if the property-altering element is in close proximity of the fluorescent polymer to cause the superquenching.

Please clarify.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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5. Claims 38-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Coull et al (6,355,421).

Coull et al disclose compositions and kits comprising PNA (peptide nucleic acid) Molecular probes. Coull et al disclose that the PNA probes comprise a probing segment (recognition element) which is designed to hybridize (bind) to a portion of a target sequence (target biological agent) (col 8, Fig. 11). Coull et al disclose the probing segment (recognition element) comprises a linker (tether) (col 15, Fig. 11) and a quencher (property-altering element).

With respect to the recitation "amplified superquenching" as recited in the instant claims. Since Coull et al disclose all the elements of the recited compound and applicant has not recited any structural differences than that of Coull et al. The compositions of Coull et al would be capable of amplified superquenching. Further, it is unclear what amplified superquenching is (see above 112 2nd rejection). Therefore, Coull et al anticipates the claims.

With respect to the fluorescent polymer recited in claim 40. Coull et al discloses that the composition can further bind with a linked fluorophore comprising 2 or more units which is a polymer. Coull et al further teaches that the fluorophore can be a dye such as Cy3 (dye comprising a series of conjugated double bonds having two quaternary nitrogen atoms at the terminal ends which share one positive charge). Therefore, Coull et al disclose a fluorescent polymer which is capable of binding the to the above stated composition. Therefore, Coull et al anticipates the claims.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 38-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,743,640. Although the conflicting claims are not identical, they are not patentably distinct from each other because one of ordinary skill in the art would recognize that the claims of the current application reciting the recognition element comprises a peptide nucleic acid would encompass the broader claim of U.S. Patent 6,743,640 recited the broader recognition element.

Conclusion

8. No claims are allowed.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gildea et al (US 6,485,901) disclose a polymer comprising PNA subunits (recognition element) which is complementary to a target sequence of interest. Gildea

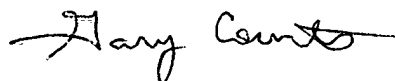
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et al disclose these PNA subunits bound to a linker (tether) and an acceptor moiety (property-altering element)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary W. Counts whose telephone number is (571) 2720817. The examiner can normally be reached on M-F 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on (571) 272-0823. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gary Counts
Examiner
Art Unit 1641
February 11, 2005



LONG V. LE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

02/14/05